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09/897,730	07/03/2001	Takashi Yasujima	49275-061	8172

7590

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EXAMINER

FOREMAN, JONATHAN M

ART UNIT

PAPER NUMBER

3736

DATE MAILED: 02/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/897,730

Applicant(s)

YASUJIMA ET AL. CM

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 - 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 13 November 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### *Drawings*

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 11/13/02 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.
2. The Patent and Trademark Office no longer makes drawing changes. See 1017 O.G. 4. It is applicant's responsibility to ensure that the drawings are corrected. Corrections must be made in accordance with the instructions below.

### **INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

#### **1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

#### **2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

### **Timing of Corrections**

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.185(a). Failure to take corrective action within the set (or extended) period will result in **ABANDONMENT** of the application.

*Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 – 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In reference to claims 1 and 8, the phrase “length significantly greater than a hand width of a user” is unclear in that is a relative term that renders the claim indefinite.

*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 1, 2 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,280,396 to Clark.

In reference to claims 1 and 8, Clark discloses a bioelectrical impedance measuring apparatus (Figure 1) comprising: a housing (12, 14, 16, and 22), a plurality of rod-like electrode members (24 and 26) having a plurality of electrodes (24a, b and 26a, b) disposed in an upper part of said housing and having a length significantly greater than a hand width of a user of the apparatus

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(in the instant that a child or infant uses the apparatus), a display device (42) having the capability of an operator panel (36) lies between the electrode members (24 and 26). Col. 5, lines 14 – 17 disclose a touch-screen display for use with the apparatus. The apparatus disclosed by Clark also comprises a weighing device (Col. 4, lines 22 - 24) in the lower part of the housing. The housing accommodates: (Figure 4) a current supplying device (32), a voltage measuring device (34) and an arithmetic means (40) for calculating a bioelectrical impedance value from the supplied current value and the measured voltage values; a modem; and a display device for displaying information which is acquired over an internet accessed through the modem (Col. 8, lines 9 – 18).

In reference to claim 2, Clark discloses a bioelectrical impedance measuring apparatus wherein the electrode members (24 and 26) are located at both side edges of the housing (Figure 3).

### *Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,280,396 to Clark as applied to claim 1 above, and further in view of U.S. Patent No. 5,817,031 to Masuo et al.

Clark does not disclose the electrode members having a circular shape. However, Masuo et al. discloses a bioelectric impedance measuring device (Figure 1) in which the electrode members (17 – 20) have a circular shape. The term “annular” used to describe the electrodes (Col 4, lines 64 – 67), implies forming a ring, which the examiner takes as a circular shape. One skilled in the art at

the time the invention was made would have been motivated to add the annular electrodes as disclosed by Masuo et al. to Clark's apparatus so that the electrodes would be in contact with the palm and fingers of the user no matter how the electrodes are gripped.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,280,396 to Clark.

Figure 5 discloses the use of electrode members shaped like horizontal rods. It would have been obvious to one skilled in the art at the time the invention was made to replace the U-shaped electrodes shown in Figure 3 with the electrodes shown in Figure 5. The electrodes are functionally the same and are therefore interchangeable.

1. Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,280,396 to Clark in view of U.S. Patent No. 6,478,736 to Mault.

In reference to claim 5, Clark discloses a bioelectrical impedance measuring apparatus comprising a display, but does not teach displaying a diet or medicine that is selected based on a percent body fat from the bioelectrical impedance value. However, Mault discloses a bioelectrical impedance measuring apparatus comprising a display capable of displaying a diet or medicine that is selected based on a percent body fat from the bioelectrical impedance value (Col. 10, lines 5 – 51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the display as disclosed by Clark to have the capabilities of displaying a diet or medicine as taught by Mault in order to provide the user feedback in terms of foods to avoid.

In reference to claim 9, Mault teaches the device being accessible at different locations (Col. 12, lines 66 – 67) and displaying information related to exercise and fitness (Col. 11, lines 36 – 57) based on a percent body fat from the bioelectrical impedance value. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include information

introducing a sporting or esthetic club, in order to provide the user with a location for performing the exercise program designed for the user.

2. Claims 6, 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,280,396 to Clark in view of U.S. Patent No. 6,478,736 to Mault as applied to claim 5 above, and further in view of U.S. 6,370,513 to Kolawa et al.

In reference to claims 6, 7 and 10, Kolawa et al. discloses an apparatus comprising a modem, being located in a store (Col. 12, lines 31 – 34), displaying inventories of the diet or medicine in another franchised store acquired over an internet accessed through the modem. The apparatus displays a location of the diet or medicine, a price, and an inventory thereof (Col. 13, lines 21 – 39). Kolawa et al. further discloses that information displayed on the device can be created with the help of a dietician (Col. 15, lines 43 – 44). It would have been obvious to one having ordinary skill in the art to combine the database and item locating capabilities of the apparatus as taught by Kolawa et al. to the apparatus as disclosed by Clark in view of Mault in order to further improve the capabilities of the device.

### *Response to Arguments*

3. Applicant's arguments filed 11/13/02 have been fully considered but they are not persuasive. Applicant has stated that the apparatus disclosed by Clark does not disclose the plurality of rod-like electrode members being significantly greater than a hand width of a user. However, as the Examiner has pointed out above, if a child or adult with small hands were to use the apparatus as disclosed by Clark, then the rod-like electrode members would be significantly greater than the width of the user's hand.

*Conclusion*

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Shepley and Iwabuchi et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (703)-305-5390. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F Hindenburg can be reached on (703)308-3130. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-308-0758 for regular communications and (703)-308-0758 for After Final communications.




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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0858.



JMLF  
January 31, 2003

  
**MAX F. HINDENBURG  
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